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REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-4 are rejected under 35 U.S.C. 102(b) over the patent to Barnhill.

Claims 1-4 are rejected also under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending application no. 10/639,114.

Also, claim 3 was rejected under 35 U.S.C. 112.

In connection with the Examiner's formal objection of claim 3, this claim has been amended and it is believed that the grounds for the formal rejection are no longer applicable.

Also, in connection with the Examiner's rejection of the claims under the judicially created doctrine of obviousness-type double patenting, it is respectfully submitted that copending application no. 10/639,114 has been abandoned. Therefore, the double patenting rejection is no longer applicable.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, claim 1 has been canceled and new claim 5, the broadest claim on file, has been submitted, together with another dependent claim 6. The retained dependent claims have been amended to depend directly or in directly on claim 5.

It is respectfully submitted that the new features of the present invention which are defined in claim 5 are not disclosed in the patent to Barnhill applied by the Examiner and also can not be derived from it as a matter of obviousness.

Turning now to the Examiner's rejection of the claims over the art, it is believed to be advisable to explain first of all the construction and the operation of the inventive socket.

The socket in accordance with the present invention has an inner opening with a plurality of recesses and with six radially inner points and twelve radially outer parts, so that six recesses are formed each between two neighboring radially outer points. In accordance with the present invention, the recesses are formed so that when after tightening of the nut on the washer the hexagonal nut (on the plan view) does not coincide with the hexagonal part under it but instead is circumferentially offset relative to the latter, it is still possible to remove the socket, or in particular its portion

which is applied on the hexagonal part, axially upwardly, by turning the socket in a circumferential direction as shown in Figure 4. In particular, in order for the recesses to be capable of doing so, each recess between two neighboring points must extend over 30° in the circumferential direction. Figure 2 clearly shows the angle of 30°, and since the drawings represent a part of the original disclosure, it is believed that there is an antecedent basis for the original disclosure for this specific angle.

Turning now to the references and particularly to the patent to Barnhill, it can be seen that this reference deals with a fast lead socket wrench. In particular, the socket wrench is designed so as to improve it in terms of angular or rotational clearance. The socket in accordance with the reference is not designed and not used for tightening, loosening or holding a hexagonal part located underneath an equally sized hexagonal nut. The socket wrench disclosed in this reference would not work for tightening, loosening or holding fasteners as in the applicant's invention, in particular when a hexagonal part is located underneath an equally sized hexagonal nut, because the angular size of each of the recesses in the inner opening of the socket disclosed in this reference is only 25°. This means that in many situations when the hexagonal nut is circumferentially turned relative to the hexagonal part over a significant distance, the socket disclosed in the reference, regardless of how much it is turned circumferentially, would not

be removed from the fastener, because the corners of the hexagonal nut would interfere with the material of the body of the socket.

Only when the recesses are formed in accordance with the present invention and the angular size of the recesses is equal to 30°, it is possible, regardless of the circumferential offset of the hexagonal nut relative to the equally sized hexagonal part underneath it, to remove the socket from the part and then axially displace it past the nut, which can be done with turning of the socket in the circumferential direction.

It is therefore believed to be clear that the new features of the present invention which are now defined in claim 5 are not disclosed in the patent to Barnhill and can not be derived from it. The same is true with respect to claim 6 whose features are also not disclosed in the patent to Barnhill and can not be derived from it.

The Examiner rejected the original claims with regards to the patent to Barnhill as being anticipated. In connection with this, it is believed to be advisable to cite the decision in *re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Barnhill does not have each and every element of the present invention as defined in claims 5 and 6.

The present invention can not be also derived from the patent to Barnhill as a matter of obviousness. In order to arrive at the applicant's invention from the teaching of the patent to Barnhill, the construction of the socket disclosed in the patent to Barnhill has to be fundamentally modified, in particular by changing the design of the recesses or in other words by including the features which are first proposed by the applicant and defined in claims 5 and 6. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *in re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Finally, it was explained herein above that the present application provides for highly advantageous results in allowing removal of a socket in any circumferentially offset position of the upper nut over the equally sized lower part, for example a washer. These highly advantageous results can not be accomplished by the construction of the socket disclosed in the reference. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claims 5 and 6 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 6, they share its presumably allowable features, and therefore it is respectfully submitted that they should also be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,


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